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04 JAN 1994

In re Application of
HEIKKILA et al
Serial No.: 07/910,133
PCT No.: PCT/FI91/00011
Int. Filing Date: 10 January 1991
Priority Date: 15 January 1990
For: A PROCESS FOR THE
SIMULTANEOUS PRODUCTION
OF XYLITOL AND ETHANOL

DECISION ON

PETITION

UNDER 37 CFR 1.181

This decision is in response to the "PETITION FOR WITHDRAWAL OF HOLDING OF ABANDONMENT" filed 14 June 1993, which has been treated as a petition under 37 CFR 1.181 and does not require a petition fee; and, the "CONDITIONAL PETITION FOR REVIVAL UNDER 37 C.F.R. 1.137(b) OF AN APPLICATION UNINTENTIONALLY ABANDONED" filed 14 July 1993 requesting revival of the above identified application and authorizing charging the requisite petition fee therefor to applicants' Deposit Account.

BACKGROUND

On 10 January 1991, applicants filed international application PCT/FI91/00011, which claimed priority of an earlier Finnish application filed 15 January 1990. A copy of the international application was received by the United States Patent and Trademark Office from the International Bureau on 01 August 1991. A Demand for international preliminary examination, in which the United States was elected, was filed on 05 June 1991. Accordingly, the thirty-two month period for entering the national stage in the United States expired at midnight on 15 September 1992.

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On 14 July 1992, applicants filed a Transmittal Letter for entry into the national stage in the United States which was accompanied by, inter alia, the requisite basic national fee as required by 35 U.S.C. 371(c)(1) and a copy of the international application. An acceptable oath or declaration of the inventors as required by 35 U.S.C. 371(4) was not included.

On 18 July 1992, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 and 37 CFR 1.494 or 37 CFR 1.495 (FORM PCT/DO/EO/905) notifying applicants that, inter alia, an oath or declaration of the applicants and the surcharge for providing the oath or declaration later than 30 months from any claimed priority date must be received by 32 months from the claimed priority date to avoid abandonment of the application in the United States of America.

On 09 September 1992, applicants filed a declaration of the inventors and the requisite \$130.00 surcharge for the late filing of the declaration later than 30 months from the priority date.

On 01 February 1993, the United States Designated/Elected Office mailed a Notification of Acceptance of Application under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495 (FORM PCT/DO/EO/903).

On 25 February 1993, The United States Designated/Elected Office mailed a Notification of Abandonment under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495 (FORM PCT/DO/909). This Notification informed the applicants that the declaration of the inventors did not identify the application properly. Specifically, the declaration filed 09 September 1993 did not identify the specification to which it was directed as required by 37 CFR 1.63(a)(2).

On 14 June 1993, applicants filed the present petition requesting withdrawal of the holding of abandonment. Applicants assert that the declaration filed 09 September 1992 properly identified the application as stated in 37 CFR 1.5(a) because, according to applicants, the declaration identified the present national stage application by the international application serial number.

On 14 July 1993, applicants filed the present conditional petition under 37 CFR 1.137(b) requesting revival of the abandoned application in the event the petition for withdrawal of the holding of abandonment was not granted. Filed with the present petition to revive was a supplemental declaration of the inventors.

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PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

A review of the declaration submitted 09 September 1992 reveals that it is defective and does not satisfy the requirements of 35 U.S.C. 371(c)(4) for entry into the national stage. Specifically, the declaration does not identify the specification to which it is directed as required by 37 CFR 1.63(a)(2). As such, the application became abandoned by operation of law at midnight on 15 September 1992 because an acceptable oath or declaration of the inventors was not filed prior to that date. Although the declaration did indicate the international application (PCT/FI91/00011) as a prior filed United States application for benefit under 35 U.S.C. 120, such an indication is error and is not considered to satisfy the requirement of 37 CFR 1.63(a)(2). Applicants' argument regarding 37 CFR 1.5(a) is not convincing. 37 CFR 1.5(a) refers to the manner in which a correspondence must identify the application to which it belongs and does not speak to the requirements of oaths or declarations. 35 U.S.C. 115 and 37 CFR 1.63 set forth the requirements for oaths and declarations. Accordingly, withdrawal of the holding of abandonment is not appropriate.

Thus, for the reasons stated above, the Notification of Acceptance of Application under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495 (FORM PCT/DO/EO/903) was erroneously mailed on 01 February 1993 and is hereby rescinded.

PETITION TO REVIVE

A petition to revive an abandoned application under 37 CFR 1.137(b) must be filed within one year of the date on which the application became abandoned or within three months of the date of the first decision on a petition under 37 CFR 1.137(a) filed within one year of the date of abandonment of the application. A petition under 37 CFR 1.137(b) must be accompanied by (1) a statement that the abandonment was unintentional, (2) a proposed response, and (3) the petition fee required by law (37 CFR 1.17(m)).

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This contingent petition to revive was filed within one year of the date of abandonment and includes a statement that the abandonment was unintentional. In addition, the requisite \$1170.00 petition fee has been charged to applicants' deposit account as authorized in the petition. Accordingly, the requirements of items (1) and (3) above have been satisfied.

In regard to item (2) above, the declaration filed with the present petition is sufficient to satisfy the oath or declaration requirements of 35 U.S.C. 371(c)(4). Accordingly, the requirement of item (2) has been satisfied.

REQUIREMENT FOR A NEW OATH OR DECLARATION

Although, the supplemental declaration filed 14 July 1993 is sufficient to satisfy 37 CFR 1.63(a)(2) and MPEP 601.01, it incorrectly identified the date of filing the specification of application Serial No. 07/910,133 as "9 September 1992". Therefore, applicants are hereby required to provide a further supplemental 37 CFR 1.63 oath or declaration under the appurtenance of 37 CFR 1.67(a), within a TWO (2) MONTH period set from the mail date of this decision which correctly identifies: 1.) the specification of which was filed on 14 July 1992 as Application Serial No. 07/910,133 (if applicants again uses the same declaration form and format), or alternatively, 2.) the filing date of the national stage application to be 10 January 1991. Extensions of this time limit may be obtained under 37 CFR 1.136(a).

CONCLUSION

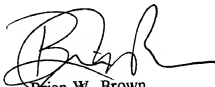
Applicants' petition requesting withdrawal of the holding of abandonment is DISMISSED.

Applicants' contingent petition for revival under 37 CFR 1.137(b) is GRANTED.

Applicants' claim for foreign priority has been acknowledged. The application will be given an international filing date of 10 January 1991 under 35 U.S.C. 363; and, a date of 14 July 1993 under 35 U.S.C. 371(c) and 102(e).


Applicants are cautioned that a correct oath or declaration (discussed above) must be provided within the two (2) month period set herein or within any period extended under the provisions of 37 CFR 1.136(a). The submission of the corrected oath or declaration should include a cover letter entitled "Response To Request to File Supplemental 37 CFR 1.63 Oath or Declaration". No additional petition fee or surcharge for filing the supplemental oath or declaration is required.

This application is being returned to the DO/EO/US for processing in accordance with this decision, that is, for mailing a Notification of Acceptance (FORM PCT/DO/EO/903) indicating a 35 U.S.C. 371(c) and 102(e) date of 14 July 1993.



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